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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,160	01/19/2001	Tetsuo Minakawa	1095.1151/JDH	7615

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

PHAM, THOMAS K

ART UNIT	PAPER NUMBER
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2121

DATE MAILED: 08/13/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/764,160

Applicant(s)

MINAKAWA ET AL.

Examiner

Thomas K Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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Notice to Applicant(s)

1. Claims 1-10 of U.S. Application 09/764160 filed on January 19, 2001 are presented for examination.

DETAILED ACTION

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 5-6 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by *Flake* et al. U.S. Patent no. 5,832,451 (hereinafter *Flake*).

Regarding claim 1

Flake teaches

- an intermediation control apparatus that carries out intermediation between a user and a service provider, the intermediation control apparatus comprising: extraction means for determining a range of personal information of a user, for disclosure, based on a kind of request information sent from said user, and extracting said range of personal information

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from said personal information (col. 19 lines 2-8, “system 10 ... requesting customer.”);

and

- transaction means for making said extracted range of personal information and contents of a request available to said service provider (col. 19 lines 8-15, “the system ... travel request”).

Regarding claim 2

Flake teaches

- an intermediation control apparatus according to claim 1, further including memory means for storing said personal information together with a user ID of said user (col. 7 lines 49-55, “the travel agent ... device 24”).

Regarding claim 3

Flake teaches

- an intermediation control apparatus according to claim 2, wherein said extraction means is responsive to said request information including said user ID (col. 8 lines 58-65, “If the current ... software subroutine 134”),
- for determining disclosure information of said personal information stored in said storage means based on said user ID and said kind of said request information, and extracting said disclosure information from said personal information (col. 8 lines 33-47, “A customer ... with the queue.”).

Regarding claim 5

Flake teaches

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- an intermediation control apparatus according to claim 1, further including a management table for managing correlation between said contents of said request and disclosure information of said personal information (col. 3 line 53 to col. 4 line 3, "a relational database ... preferred vendors").

Regarding claim 6

Flake teaches

- an intermediation control apparatus according to claim 5, wherein said extraction means determines said disclosure information based on said management table (col. 4 line 60-67, "The business ... profile information").

Regarding claim 10

Flake teaches

- a computer-readable recording medium which stores an intermediation control program for causing a computer to execute intermediation control, said intermediation control program causing said computer to function as: extraction means for determining a range of personal information of a user, for disclosure, based on a kind of request information sent from said user, and extracting said range of personal information from said personal information (col. 19 lines 2-8, "system 10 ... requesting customer."); and
- transaction means for making said extracted range of personal information and contents of a request available to said service provider (col. 19 lines 8-15, "the system ... travel request").

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5. Claims 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by *Luchs* et al. U.S. Patent no. 4,831,526 (hereinafter *Luchs*).

Regarding claim 8

Luchs teaches

- a service providing apparatus connected to a network, comprising: disclosure information-receiving means for receiving disclosure information as a portion of request information received from a user, said portion being permitted to be disclosed (col. 6 lines 25-33, "Once the ... policy request."); and
- response information-transmitting means for transmitting commodity information created based on said disclosure information, as response information (col. 15 line 63 to col. 16 line 12, "Once the proper ... calculated at 78.").

Regarding claim 9

Luchs teaches

- A service providing apparatus according to claim 8, wherein said disclosure information-receiving means receives, as said request information sent from said user, disclosure information which is a portion of a request of an estimate of an insurance, said portion being permitted to be disclosed (col. 3 lines 29-38, "Although all ... his insurance.").

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Flake* in view of *Walker* et al. U.S. Patent no. 5,794,207 (hereinafter *Walker*).

Flake teaches an intermediation control apparatus according to claim 1, wherein said transaction means makes said extracted range of personal information and said contents of said request available to said service provider on a site but *Flake* does not teach service provider is permitted to access the personal information of user through authentication. However, *Walker* teaches service provider is permitted to access the personal information of user through authentication (col. 9 lines 17-22, "a potential seller ... by the buyer"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the authentication of the suppliers of *Walker* with the intermediation travel service of *Flake* because it would provide for uniquely identify the supplier (i.e. airline) and to ensure the capacity to deliver the goods to the buyer before complete the transaction.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Flake* in view of *Luchs* et al. U.S. Patent no. 5,794,207 (hereinafter *Luchs*). *Flake* teaches an intermediation control apparatus according to claim 1, wherein said extraction means determines said range of personal information of said user, for disclosure, as said request information sent from said user,

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and extracts said range of personal information from said personal information but does not teach the request is an estimating request of an insurance and a type of said insurance. However *Luchs* teaches the request is an estimating request of insurance and a type of said insurance (col. 16 lines 13-21, "Once the ... policy quote 82."). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the request for insurance of *Luchs* with the intermediation travel service of *Flake* because it would provide for getting the insurance quotation and type in order to buy additional travel insurance or life insurance before starting the trip.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thomas Pham; whose telephone number is (703) 305-7587 and fax number is (703) 746-8874, Monday-Thursday and every other Friday from 7:30AM- 5:00PM EST or contact Supervisor Mr. Anil Khatri at (703) 305-0282.

Any response to this office action should be mailed to: **Director of Patents and Trademarks Washington, D.C. 20231**, or **Hand-delivered** responses should be brought to **Crystal Park II, 2121 Crystal Drive Arlington, Virginia, (Receptionist located on the 4th floor)**, or fax to the **official fax number (703) 872- 9306**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Thomas Pham
Patent Examiner

tp
August 9, 2003

Ramesh Patel
RAMESH PATEL
PRIMARY EXAMINER 8/10/03
For Anil Khatri